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AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Roy Bradshaw
v.
Cabela's, Inc.

Cancellation No. 92028640

Roy Bradshaw, pro se.

Barry L. Kelmachter of Bachman & LaPointe, P.C. for
Cabela's, Inc.

Before Simms, Chapman, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Respondent, Cabela's, Inc., is the owner of
Registration No. 2,119,664, which issued on the Principal
Register on December 9, 1997. The registration is for the
mark REALIMAGE (typed) for goods identified as "fishing
equipment, namely, fishing lures" in International Class 28.
The application that resulted in Registration No. 2,119,664,
was filed as an intent to use application on November 21,
1996, and the registration contains an allegation of a date

of first use and a date of first use in commerce of January, 20, 1997.

Petitioner, Roy Bradshaw, filed a petition to cancel respondent's registration on March 5, 1999, and subsequently amended his petition to cancel on October 12, 1999. In the amended petition (p. 2), petitioner alleges that "[s]ince long prior to the date of first use of the REALIMAGE mark by Cabela's, and/or the filing date of Cabela's application to register such mark, the REAL IMAGE and REEL IMAGE trade designations¹ have been used by Petitioner for a business and goods similar [to respondent's]." Petitioner also alleges that he will be damaged by the continuing existence on the Principal Register of "Cabela's registration of the REALIMAGE mark and by Cabela's use of the REALIMAGE mark, because such registration is likely to cause confusion among consumers between Cabela's REALIMAGE mark and Petitioner's REAL IMAGE and REEL IMAGE trade designations." Amended Petition at 3. Respondent denied the salient allegations of the amended petition to cancel.

The Record

The parties have identified the following matters as being of record in this proceeding: the file of the involved registration; the trial testimony deposition

¹ We understand that petitioner uses this term to refer to his trade name and trademark use.

of petitioner dated September 19 and 20, 2002, and October 23, 2002, with accompanying exhibits; the trial testimony deposition of petitioner dated February 7, 2003, with accompanying exhibits;² the trial testimony deposition of Donald Kim Norton, respondent's fishing product manager with accompanying exhibits; the trial testimony deposition of Catherine Louise Peters, a paralegal for respondent, with accompanying exhibits; the trial testimony deposition of Michael Callahan, respondent's director of merchandise with accompanying exhibits; respondent's notices of reliance dated November 22³ and 26, 2002; and petitioner's notices of reliance dated December 16, 2002; December 17, 2002; and January 14, 2003.

Priority

A party petitioning to cancel a federally registered trademark must plead and prove that it has standing and that

² This deposition was taken after petitioner's rebuttal period. Respondent was willing to allow the taking of rebuttal testimony after the close of the rebuttal provided that "the deposition would continue day-to-day until completed without any multi-day or multi-weekday hiatuses." Dep. at 4. While petitioner never formally agreed to this condition, the deposition did take place within one day. However, the deposition is difficult to understand and the exhibits consist primarily of petitioner's notes on other witnesses' deposition testimony. However, we will consider the deposition to be of record.

³ The copy of the notice of reliance in the file identifies six registrations. Copies of these registrations are not attached to the board's copies but duplicate copies of five of these registrations were attached to the deposition of Catherine Louise Peters. In order to avoid delaying this proceeding, we have also considered Registration No. 1,151,981 for the mark CABELA'S from the USPTO's database.

there is a valid ground for the cancellation of the registration. Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998) ("Section 14 has been interpreted as requiring a cancellation petitioner to show (1) that it possesses standing to challenge the continued presence on the register of the subject registration and (2) that there is a valid ground why the registrant is not entitled under law to maintain the registration") (internal quotation marks omitted).

For standing, petitioner asserts his ownership of common law "trade designations REAL IMAGE and REEL IMAGE" and the ground of likelihood of confusion.⁴ Amended Petition at 2. Petitioner, as a competitor of registrant who has alleged that he has common law rights in a similar term, has standing to seek cancellation of respondent's registration. However, in order to prevail in this case, petitioner must show that he has priority, and that there is a likelihood of confusion.

Under the rule of Otto Roth, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through "whatever other type of

⁴ Respondent argues that petitioner "could have argued priority of use on the basis that his use of the terms 'REAL IMAGE' and 'REEL IMAGE' was analogous to trademark use, but he has chosen not to proceed in this manner and for good reason." Respondent's Brief at 38. While we agree with respondent to the extent that we hold that petitioner is not relying on use analogous to trademark use, we do hold that petitioner is relying on trademark and trade name use of the terms REEL IMAGE and REAL IMAGE.

use may have developed a trade identity." Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). The Otto Roth rule is applicable to trademark registration cancellation proceedings as well.

Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (full citation added).

At this point, we need to determine not only petitioner's date of use of the trademark or trade name REAL IMAGE or REEL IMAGE but also whether the term is distinctive.

We start with the question of whether the term REAL IMAGE or its phonetic equivalent REEL IMAGE is inherently distinctive, and if it is not inherently distinctive, whether it has acquired distinctiveness.

Petitioner has indicated that his mark REAL IMAGE or REEL IMAGE is not inherently distinctive: "Petitioner's REAL IMAGE and REEL IMAGE marks have acquired distinctiveness, giving the consuming public an instantly recognizable and reliable connection, interrelated and inseparable, identifying Petitioner as the source of his goods." Petitioner's Brief at 15. Petitioner has also explained that "'real image' is a technical term to describe one of the four images found within a hologram, which are 'virtual,' 'real,' 'pseudoscopic' and 'orthoscopic images,' although Petitioner's 'REAL IMAGE' and 'REEL IMAGE' marks *do describe and evoke the essence* of Petitioner's unique 'real

images' of fish."⁵ Petitioner's Brief at 14-15 (emphasis added).

Petitioner's statement in his brief is supported by relevant dictionary excerpts. "Real image" is defined as "an optical image formed as of real foci." *New International Dictionary of the English Language (Unabridged)* (1986). Under the definition of "holography," the explanation includes the following information, "[i]n addition to the *virtual* or *primary image*, a real, or *conjugate image* will be formed on the observer's side of the hologram. *Van Nostrand's Scientific Encyclopedia* (8th ed. 1995) (Italics in original).⁶ We agree with petitioner's observation that "real image" is a term that would describe his goods.⁷ We also note that even if prospective purchasers would not be aware of the technical definition, they would be aware that the term "real" simply means "actual." *Webster's II New Riverside University Dictionary* (1984). Petitioner's own advertising touts the claim that his goods resemble actual fish. See Bradshaw dep., Ex. 10

⁵ Petitioner also maintains that the "average consumer encountering Petitioner's product would not immediately know that the term 'real image' is a technical term." Petitioner's Brief at 14.

⁶ We take judicial notice of these definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁷ Petitioner has not sought to cancel respondent's mark on the ground that the mark is merely descriptive nor was this issue tried by consent. Therefore, this issue is not before us.

("Catch the Realism" and "changes color & movement. Fresh Water or [S]alt. Life like actions") and Ex. 32 ("The hologram shows lifelike images").⁸ Based on these definitions, we cannot say that petitioner's trade designations are inherently distinctive. A "real image" is a technical term that petitioner admits describes its products. For that reason alone, petitioner's mark would not be inherently distinctive. Beyond that, the term "real image" would also describe the fact that petitioner's goods attempt to produce an "actual" or "real" image of fish or other bait. See, e.g., Bradshaw dep., Ex. 14 ("Holographic images of real fish make Fish Laser lures and attractors unique - and effective" and "These lures ... use three-dimensional-looking holographic images of real fish"). To the extent that petitioner is also relying on the phonetic equivalent "reel image," it is similarly descriptive. The use of a phonetically identical word or a simple misspelling does not normally change a descriptive word into a suggestive term.

The word, therefore is descriptive, not indicative of the origin or ownership of the goods; and being of that quality, we cannot admit that it loses such quality and becomes arbitrary by being misspelled. *Bad orthography has not yet become so rare or so easily detected as to*

⁸ Exhibit 32, which appears to be an advertisement for his product is marked "confidential." It is not clear what is confidential about this exhibit, and clearly the above-quoted material, which is similar to other material in the record, which is not marked as confidential, does not appear to be confidential.

make a word the arbitrary sign of something else than its conventional meaning...

Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446, 455 (1911) (emphasis added). See also In re Quik-Print Copy Shops, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) (QUIK-PRINT held descriptive; "There is no legally significant difference here between 'quik' and 'quick'").

While petitioner uses the term "reel" instead of the word "real" in some versions of his term, both terms (REAL IMAGE and REEL IMAGE) would be pronounced identically and they would have similar if not the same meaning when viewed in relation to fishing lures. Cf. In re Priefert Mfg. Co., 222 USPQ 731, 733 (TTAB 1984) (Applied-for mark "HAY DOLLY" reminiscent of the famous Broadway hit "HELLO DOLLY"). Petitioner's use of the term "reel" instead of "real" simply reinforces the fishing association with petitioner's goods.

Therefore, because we agree with petitioner that his mark is merely descriptive, we next move to whether his trade name has acquired distinctiveness. Petitioner argues that: "For more than 15 years, Petitioner has used the 'REAL IMAGE' and 'REEL IMAGE' marks in commerce. Petitioner's REAL IMAGE and REEL IMAGE marks have achieved acquired distinctiveness." Petitioner's Brief at 15. On this point, we note that petitioner has submitted numerous invoices, generally involving relatively small sales (Bradshaw dep., Ex. 55 (001540 - \$15.30), (001541 - \$41.25);

(001542 - \$38.08); (001543 - \$19.80); (001544 - \$27.60);
(001545 - \$12.40); (001546 - \$32.74); and (001547 - \$9.40).⁹

Petitioner has also included copies of advertisements and articles concerning his trade name over the years from periodicals including the *Ohio Fisherman*, *The Fish Sniffer*, and *Great Lakes Fisherman*.

Petitioner in this case has the burden of proving that his mark has acquired distinctiveness. In re Hollywood Brands, Inc., 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." Yamaha Int'l Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988).

However, the statute is silent as to the weight of evidence required for a showing under Section 2(f) except for the suggestion that substantially exclusive use for a period of five years immediately preceding filing of an application may be considered prima facie evidence.

As observed by our predecessor court, the exact kind and amount of evidence necessarily depends on the circumstances of the particular case, and Congress has chosen to leave the exact degree of proof necessary to qualify a mark for registration to the judgment of the Patent Office and the courts. In general, the greater

⁹ There are occasional larger sales. See, e.g., Bradshaw dep., Ex. 55, 001453 - \$242.98 and 001361 - \$863.90. While these exhibits are marked as confidential, the simple fact that a sale of this amount occurred does not, by itself, appear to be confidential business information.

the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning.

Id. (quotation marks, brackets, and citations omitted).

We find that petitioner's evidence of small-scale sales over numerous years and his sporadic advertising and coverage in periodicals over the years falls far short of meeting his burden of demonstrating that his mark has acquired distinctiveness.¹⁰ Therefore, petitioner has not established that he can prevail in this petition to cancel.

Other Issues

Although we find that petitioner has not established that his trade name or trademark has acquired distinctiveness prior to respondent's constructive use date, for the sake of completeness, we address the remaining issues in this case. Respondent's application that matured into the registration at issue was filed on November 21, 1996. Respondent can rely on this date for its priority, and in order to prevail on priority, petitioner would have to establish an earlier date. 15 U.S.C. § 1057(c).

Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154, 156 n. 5 (TTAB 1985) ("The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application"). Respondent does not seek to establish an

earlier date of use. Respondent's Brief at 16 ("Registrant will live with its constructive use date of November 21, 1996").

At this point, we add that if the issue were simply who used the trade name or trademark REEL IMAGE or REAL IMAGE first, the answer would clearly be petitioner. Petitioner has submitted numerous invoices, articles, and advertisements, dated years before respondent's constructive first use date that demonstrates that he was using the term before November 21, 1996. See, e.g., Bradshaw dep., Ex. 55 001522 (REALIMAGE - FISH LASER dated June 30, 1994); Ex. 56 001822 (REAL IMAGE - October 2, 1995); *The Fish Sniffer*, July 9-23, 1993 ("Real Image, was the first to produce holographic taped fishing lures"). However, as discussed earlier, inasmuch as petitioner has not established, at a minimum, that his trade name has acquired distinctiveness as of November 21, 1996, the fact that we find that petitioner has demonstrated that he used the term REAL IMAGE/REEL IMAGE prior to respondent does not entitle him to prevail.

Likelihood of Confusion

Another issue we address is whether there is a likelihood of confusion between petitioner's trade name REAL IMAGE and REEL IMAGE and respondent's REALIMAGE mark

¹⁰ This limited evidence of sales and advertising also undercuts petitioner's argument that his "marks have come to be and are now well known." Petitioner's Brief at 48.

used on fishing lures. We consider the facts in this case against the background of the factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The first factor we consider is the similarities or dissimilarities in the marks. In this case, the marks or trade names are either virtually identical or phonetically identical (REAL IMAGE, REEL IMAGE, and REALIMAGE).¹¹ The marks REALIMAGE and REAL IMAGE are virtually identical and the absence of a space does not make the terms dissimilar. Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52, 54 (TTAB 1983), aff'd, 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984) ("There is no question that the marks of the parties [STOCKPOT and STOCK POT] are confusingly similar. The word marks are phonetically identical and visually almost identical"). In addition, petitioner's trade name REEL IMAGE would likewise be similar to respondent's REALIMAGE mark. The only difference would be the use of the phonetically equivalent term "reel" instead of "real." In

¹¹ While petitioner does not seek to cancel the registration on the basis that he is using the identical term REALIMAGE, as noted earlier there is evidence that petitioner uses this identical term. Bradshaw dep., Ex. 55 (001522).

the category of fishing products, the term "reel" would not create a double entendre that would sufficiently distinguish the marks. We specifically find that the commercial impressions of the terms REALIMAGE and REEL IMAGE/REAL IMAGE would not be significantly different. The fact that respondent's "REALIMAGE products sold by Registrant prominently display Registrant's house and world famous mark 'CABELA'S'" (Respondent's Brief at 43) is not relevant to a determination of whether the marks in this case are confusingly similar. We note that respondent's registration is not for the mark CABELA'S REALIMAGE but simply the mark REALIMAGE.

Regarding respondent's fishing lures and petitioner's fishing lures and its business of selling fishing lures, we note that even if petitioner cannot establish use of his trademark on fishing lures, the evidence shows that petitioner is using the term as a trade name to identify his business of selling fishing lures. These goods and trade name uses would be very similar.

The only aspect of this case which is unusual is that the marks sought to be registered are for services while the prior registration on which their registration is refused is for wares. Considering the facts (a) that trademarks for goods find their principal use in connection with selling the goods and (b) that the applicant's services are general merchandising -- that is to say selling -- services, we find this aspect of the case to be of little or no legal significance.

In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

Respondent also argues that because "of the manner in which Registrant's goods are sold, Registrant's goods bearing its REALIMAGE mark and Petitioner's goods will never appear side-by-side in the marketplace."¹² Respondent's Brief at 43. However, there are no restrictions in the identification of goods in respondent's registration and we do not read limitations into the identification of goods. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration"). Therefore, regardless of how respondent markets its goods or even if its goods are only sold in its company-owned stores, we must consider them as they are identified in its identification of goods. Certainly, with this unrestricted identification of goods, the fact that the evidence may indicate that respondent currently sells through its catalogs and company-owned

¹² Respondent's witness stated that it does not sell its fishing lures through non-company owned discount stores. Callahan dep. at 12. Although this deposition was marked "confidential," respondent has referred to this portion of the deposition in its non-confidential brief (p. 49). Respondent also argues that "Wherever a consumer turns when he/she buys Registrant's REALIMAGE goods, one will always see the Cabela's name."

stores does not allow respondent to avoid confusion by showing that it will only use the mark in its own store surrounded by its house mark. We must assume that respondent's fishing lures are sold in all the normal channels of trade. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages").

Respondent also argues that its "REALIMAGE goods have been sold for more than six years set forth above and there has not been any instance of actual confusion as to source." Respondent's Brief at 44 (emphasis omitted). The lack of evidence of actual confusion does not, by itself, normally lead to a conclusion that there is no likelihood of confusion. J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991); Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). In this case, where respondent has admitted purchasing fishing lures from petitioner at least in 1989-1990 (Respondent's Brief at 20), there may be less reason for purchasers to articulate any

questions they have concerning whether respondent is currently still purchasing fishing lures from petitioner.

When we consider all of the factors in this case, we conclude that petitioner would meet his burden on the question of likelihood of confusion.

Evidentiary Objections

Both parties have made numerous evidentiary objections throughout this proceeding. Respondent best summed up the state of these objections when it admitted that there "are numerous objections raised throughout the Deposition Transcripts of Petitioner regarding questions and answers by Petitioner. Since they are *too numerous to mention here*, the Board is requested to rule on them during its reading of the Transcripts." Respondent's Brief at 11 (emphasis in original). "[B]y failing to preserve the objection in its brief, a party may waive an objection that was seasonably raised at trial." TBMP § 707.04. See also Volkswagenwerk AG v. Clement Wheel Company, Inc., 204 USPQ 76, 83 (TTAB 1979) ("All other objections made during the depositions are considered to have been dropped because they were not argued in the briefs") (underlining added). While respondent's blanket statement above does not amount to arguing the objections in its brief, we do briefly address some of these objections. Petitioner was not represented by counsel at the time of his testimonial depositions. The deposition

consisted of petitioner asking himself questions and counsel for respondent objected frequently on the grounds that questions were leading, irrelevant, asked-and-answered, etc. Petitioner received the objections almost as if they were rulings from a presiding official. Indeed, counsel's objections often sounded like rulings. See, e.g., Bradshaw dep. at 48 ("You can't ask yourself yes-or-no questions," and "You have to rephrase the question"). We start by noting that "it is difficult to see how a question propounded by a witness who is examining himself can rationally be objected to as leading." Hutter Northern Trust v. Door County Chamber of Commerce, 467 F.2d 1075, 1078-79 (7th Cir. 1972). If these objections were not deemed to be waived, we would overrule respondent's relevancy and "asked and answered" objections. Similarly, we would overrule petitioner's relevancy and lack of knowledge objections to respondent's evidence and testimony.

Regarding other evidentiary objections of respondent to petitioner's evidence, the most serious objections concern petitioner's three notices of reliance filed in December 2002. These notices of reliance were filed prior to the opening of petitioner's rebuttal testimony period. We find that respondent's objection is untimely because if it had been timely raised, petitioner could easily have corrected

this defect.¹³ See Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (Objection to premature deposition waived. "We agree with opposer that the error in taking the testimony early was made in good faith and that applicant waived its objection ... which could have been corrected upon seasonable objection").

We agree with respondent that, to the extent that petitioner is using newspaper articles to prove the truth of the matter asserted in those articles, that would be hearsay. We specifically overrule respondent's relevancy objections to petitioner's patents. We also overrule respondent's objections to petitioner's introduction of his own discovery deposition during his testimony. In effect, the witness was adopting his own previous deposition testimony as his testimony deposition. Petitioner was obviously available for cross-examination and any error in its introduction was harmless. Regarding respondent's other

¹³ For similar reasons, we overrule respondent's objection to petitioner's submission of exhibits, which were his answers to respondent's interrogatory Nos. 31 through 36. Petitioner submitted his responses to these interrogatories inasmuch as respondent had relied on petitioner's response to one interrogatory in which petitioner referenced his responses to these other interrogatories. Respondent objects (Brief at 7) because the exhibits "did not form part of Petitioner's answer to the interrogatories." Petitioner responds by noting that his responses "contained references to Bates numbered documents not the actual documents. At the time when Petitioner provided his Responses, Registrant had the underlying documents for his review." Reply Brief at 5. Again, if respondent had filed a prompt objection, petitioner may have been able to cure any possible defect.

objections, we have considered them and we have given all this evidence its appropriate weight.

Conclusion

Respondent's registration is presumed valid, and a petitioner seeking to cancel a registration must rebut this presumption by a preponderance of the evidence. Cerveceria Centroamericana S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[I]n a [trademark registration] cancellation for abandonment, as for any other ground, the petitioner bears the burden of proof. Moreover, the petitioner's burden is to establish the case for cancellation by a preponderance of the evidence"). See also Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993). In this case, we are not convinced that petitioner's trade name or trademarks have acquired distinctiveness prior to respondent's constructive use date. Therefore, the petition to cancel respondent's registration must fail.

Decision: The petition to cancel Registration No. 2,119,664 is denied.